

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte ROBERT J. MILETI

---

Appeal No. 96-3885  
Application 08/255,076<sup>1</sup>

---

ON BRIEF

---

Before COHEN, STAAB, and CRAWFORD, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 3, 7 through 10, 13 through 17, and 19. The examiner has indicated that claim 18, the only other claim remaining in the application, is objected to as being dependent upon a rejected

---

<sup>1</sup> Application for Patent filed June 7, 1994, which is a continuation-in-part of application 08/018,839, filed February 18, 1993, now abandoned.

Appeal No. 96-3885  
Application No. 08/255,076

claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Appellant's invention pertains to a toy for being launched by a person in a manner similar to a sling through the air to impart speed to the toy and create airflow past the toy, to a process of preparing a readily packagable throwing toy, to a throwing toy, and to a toy for being launched through the air to impart speed to the toy and to create airflow past the toy. An understanding of the invention can more fully be derived from a reading of exemplary claims 1, 8, 15, and 19, as they appear in the application file. <sup>2</sup>

As evidence of obviousness, the examiner has applied the patents listed below:

Klahn et al. (Klahn)	4,151,674	May 1, 1979
Stauffer	4,290,226	Sep. 22, 1981
Waters	4,624,648	Nov. 25, 1986
Hill	4,790,788	Dec. 13, 1988

---

<sup>2</sup> We have relied upon the claims as they appear in the application file in light of errors found in the copies of the claims appended to appellant's brief.

Appeal No. 96-3885  
Application No. 08/255,076

The following rejections are before us for review.

Claims 1 through 3, 6, 7, and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hill in view of Waters, and vice versa.

Claims 1 through 3, 6, 7, and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hill in view of Waters, and vice versa, as applied above, further in view of Stauffer.

Claims 8 through 10 and 13 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hill in view of Waters, and vice versa, as earlier applied, further in view of Klahn.

Claims 8 through 10 and 13 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hill in view of Waters, and vice versa, as earlier applied, further in view of Stauffer and Klahn .

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper

Appeal No. 96-3885  
Application No. 08/255,076

No. 11), while the complete statement of appellant's argument can be found in the brief (Paper No. 10).

#### OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims,<sup>3</sup> the applied patents,<sup>4</sup> and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

We do not affirm any of the examiner's rejections of

---

<sup>3</sup> In claims 1 and 19, lines 4 and 3, respectively, change "A" from the upper case to the lower case --a--. Claim 1, line 8, "won" should apparently be --own--. Dependent claims 2, 3, 6, and 7, line recite a "throwing" toy, while parent claim 1 does not.

<sup>4</sup> In our evaluation of the applied patents, we have considered all of the disclosure of each patent for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teaching of each patent, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Appeal No. 96-3885  
Application No. 08/255,076

appellant's claims under 35 U.S.C. 103.

Initially, we make note of the following claim language interpretations. We understand the recitation of "substantially rigid", relative to the ring-like structure, to denote a rigid structure that may have some flexibility (specification, page 6). As to the "ring-like" structure, we understand this recitation to denote a structure that is as round as possible, but not having perfect roundness (specification, page 6). As regards to the recitation of "sheetlike", we understand that term to denote something akin to a sheet (specification, page 6) that is thin in comparison to its length and breadth.

We turn now to the examiner's obviousness rejections.

Each of the examiner's rejections is founded upon the basic combination of the Hill and Waters patents.

Simply stated, we are of the view that one having ordinary skill in the art would not have been motivated to modify the aerial toy of Hill as proposed since the specified alteration would destroy the patentee's intended functioning of the toy.

Appeal No. 96-3885  
Application No. 08/255,076

More specifically, the Hill patent points out (column 2, lines 35 through 43) that by "compressing" the toy to where the trailing sides meet and throwing it with a rifling action, as the toy is released the flexible cylinder rebounds to its rest or open shape as it leaves the thrower's fingertips. Thus, the patentee desires a compressible and flexible cylinder (sail or airfoil) which can automatically return to its open shape. Replacing the compressible sail of Hill with a trailing portion not intended to be compressed and with a rebound function (Waters), as proposed, would clearly defeat patentee Hill's objective for his aerial toy.

Considering the examiner's alternative application of the applied art, it likewise appears to us that the collective teachings lack any express or implicit incentive for completely altering the disclosed use of the aerial toy of Waters based upon the Hill teaching of a distinctly different aerial throwing toy.

We have also assessed the respective teachings of Stauffer and Klahn but find that they do not overcome the noted deficiencies of the Hill and Waters references.

Appeal No. 96-3885  
Application No. 08/255,076

NEW GROUNDS OF REJECTION

Under the authority of 37 CFR § 1.196(b), this panel of the board introduces the following new grounds of rejection.<sup>5</sup>

Claims 1 and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Waters.

Anticipation under 35 U.S.C. §102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Paulsen, 30 F.3d 1475, 1478-1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in

---

<sup>5</sup> This panel of the board has considered appellant's view of the Waters patent as expressed in the brief (pages 6 and 7).

Appeal No. 96-3885  
Application No. 08/255,076

the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983); cert. denied, 465 U.S. 1026 (1984).

The aerial toy of Waters (Figure 5; column 4, line 43 to column 5, line 6) comprises, inter alia, a substantially rigid ring structure (forward portion) and a cylindrical sleeve (trailing portion) of cloth, cloth-like (Nylon), or plastic (polyethylene) sheet. The aforementioned sleeve of the noted material is understood to be in a collapsed state without airflow. Further, the toy is perceived to be clearly capable of being launched by a person in a manner similar to a sling through the air to impart speed to the toy and to create airflow past the toy (claim 1) and clearly capable of being launched through the air to impart speed to the toy to create airflow past the toy (claim 19). The toy of claims 1 and 19 is, accordingly, anticipated by the aerial toy teaching of Waters.

Claims 2, 3, 6 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over Waters.

In our opinion, the disclosure in Waters (Figures 10, 11;



Appeal No. 96-3885  
Application No. 08/255,076

column 6, lines 64, 65) of a plastic tube 55 would have been suggestive of the selection of an appropriate material from among conventional plastic materials (claims 2 and 3). Similarly, the teaching of plastic sheets (such as polyethylene) by Waters (column 5, lines 3 through 6) would have been suggestive of the selection of an appropriate plastic material (claim 6). In our opinion, the recitation of "sewing or other convenient operation" by Waters (column 3, lines 52 through 55) would have been understood as encompassing other known forms of securement and suggestive of, for example, adhesive (claim 7).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of

Appeal No. 96-3885  
Application No. 08/255,076

rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

In summary, this panel of the board has REVERSED each of the examiner's rejections under 35 U.S.C. § 103. Additionally, new grounds of rejection have been introduced pursuant to 37 CFR § 1.196(b).

Appeal No. 96-3885  
Application No. 08/255,076

The decision of the examiner is reversed.

REVERSED

37 CFR § 1.196(b)

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

Appeal No. 96-3885  
Application No. 08/255,076

St. Onge Steward Johnson & Reens  
986 Bedford Street  
Stamford, CT 06905